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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/009,614 | 12/14/2001 | Friedhelm Eisenbeiss | MERCK 2337 | 3719 |
| 23599 | 7590 | 01/29/2004 | EXAMINER | |
| MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201 | | | NOLAND, THOMAS | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2856 | |

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------------|-------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/009,614 | EISENBEISS ET AL. |
| | Examiner Thomas P. Noland | Art Unit 2856 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 29 October 2003.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 2-12 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 8-12 is/are allowed.
 6) Claim(s) 2-7 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____

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1. The amendment filed Oct. 29, 2003 has been entered.
2. Headings will be inserted into the specification by examiner's amendment should a response by Applicant place the application otherwise in condition for allowance. Such headings do not comprise claim limitations and are simply reading aids for future readers of interest in analyzing the disclosure.
3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on Oct. 29, 2003 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.
4. Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elwenspoek et al in view of Parce et al WO 98/00231.

Parce et al as seen especially from its abstract, Fig. 13 and page 233, paragraph bridging first and 2nd columns discloses what appears to be a miniaturized analytical system or at least discloses the use of miniaturized components for such an analysis system. There appears to be no specific disclosure as to which elements in Fig. 13 are or are not miniaturized so applicant's conclusion that most of the components therein are not is not supported. Since clearly directed to the use of miniaturized elements it seems reasonable to infer that they are or at least would have

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been obvious to have made miniaturized. Even if the pumps and valves taught in the microanalysis system of Elwenspoek et al are not microvalves Parce et al teaches on page 28, lines 25-32 that such are known expedients in such systems to assist in controlling flow in such systems and thus such would have been an obvious expedient to have used in Elwenspoek to help control the flow therein as desired. The incorporation of such valves would inherently act to control the flow as claimed. Fig. 13 of Parce et al shows both parallel and serial sections. Since in a microscopic system the valves and pumps could be considered as micro valves and micro pumps. Presumably the sealing of the pumps into the system is tight since leakage is undesirable.

5. Claims 8-12 have been allowed.

6. Applicant's arguments filed Oct. 29, 2003 have been fully considered but they are not persuasive. Applicant's arguments that the applied references do not teach the use of disposable elements or an integrated system have been noted but it is noted such is not claimed. Applicant's other arguments re claims 2-7 are believed adequately addressed in the rejection..

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

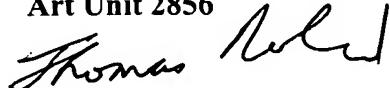
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Noland whose telephone number is (703) 305-4765. Beginning January 27, 2004 telephone number (571) 272-2202 should be used. The examiner can normally be reached on weekdays from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Hezron E. Williams, can be reached on (703) 305-4705. Beginning Jan. 27, 2004 his telephone number will be (571) 272-2208.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Thomas P. Noland
Primary Examiner
Art Unit 2856



tpn
Jan. 23, 2004